

REMARKS

Applicants appreciate the careful examination given to the Application as reflected in the Office Action mailed March 6, 2006. Reconsideration and favorable action in this Application is respectfully requested.

Claims 1-3, 42-45 and 47 remain pending and rejected in this Application.

Claims 1-3, 42, 44, 45 and 47 have been amended.

Claim 4 has been canceled.

Election/Restriction

The Office Action requires restriction to one of the following inventions under 35 U.S.C. §121:

Group I: Claims 1-4, 42-45 and 47, drawn to a double sided adhesive tape on a base sheet, classified in class 428, subclass 42.2

Group II: Claims 7-15, drawn to a corrugated base sheet with a single sided adhesive tape, classified in class 428, subclass 40.1

Pursuant to a telephone conference between the Examiner and Applicants' attorney of record on February 22, 2006, Applicants elect without traverse to prosecute Group I, Claims 1-4, 42-45 and 47.

§112 Rejection

The Office Action rejects Claim 4 under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. Although Applicants disagree with this rejection, claim 4 has been canceled.

The Office Action has also rejected claims 1-4 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter the

Applicants regard as their invention. Applicants have amended claim 1 to distinctly claim subject matter Applicants regard as their invention. Support for this amendment is found in the specification at p. 6, lns. 2-3.

An Applicant is entitled to claims as broad as the prior art and the application disclosure will allow. *In re Rasmussen*, 650 F.2d 1212, 1215 (C.C.P.A. 1981). The breadth of a claim should not be equated with the indefiniteness. *In re Miller*, 441 F.2d 689, 693 (C.C.P.A. 1971). A claim is not indefinite, despite its breadth, if those skilled in the art would understand the subject matter that falls within the scope of the claim. *Id.* 692-693.

The limitations of claim 1, while broad are not indefinite. The range of the strength of the adhesive required by the claim does not preclude one of ordinary skill in the art from determining the strength of adhesive that would be infringing. If the strength of the adhesive provides a sticking sensation, then the adhesive is of a sufficient strength to be covered by the claim. If the strength of the adhesive is not releasable, then it is too strong and falls outside the claim. The range is definite. The fact that multiple strengths of adhesive may be used does not render the claim indefinite, but rather renders the claim broad. Comments in the Office Action support Applicants' position.

The Office Action observes that the adhesiveness of adhesive tapes in *Avery* "is of sufficient strength to create an unpleasant sticking sensation to pets" and so is presumed to be definite by merely reciting some level of tackiness.

Therefore, it is submitted that claim 1 (and pending claims 2 and 3) are now definite and comply with the requirements of 35 U.S.C. §112, second paragraph.

§103(a) Rejection of Claim over Avery Adhesive in light of Kriozere

The Office Action rejects claim 1 under 35 U.S.C. §103(a) as being unpatentable over *Avery* (Italian Patent No. 590,156) in view of *Kriozere* (U.S. Patent No. 4,348,440).

Initially, the Applicants respectfully submit that *Avery* cannot be properly combined with *Kriozere* because there is insufficient suggestion or engineering motivation to do so. For example, if the double sided tab of *Avery* is added to the disclosure of *Kriozere*, an unworkable combination results because when the pressure sensitive seal member of *Kriozere* is folded over as shown in Fig. 4, the remaining outside flaps (shown at 32 and 34 in Fig. 4) would be sticky and therefore, the seal of the envelope would be useless. Similarly, if the two removable backing strips covering the adhesive layer of *Kriozere* are added to the invention of *Avery*, another unworkable combination results. Referring to Fig. 1 of *Avery*, the suggested combination would require the release sheet 13 to be in two pieces. The Office Action makes the observation that the advantage of the combination (and hence why it would be obvious) would be that removing the release layer could be used to align the adhesive strip on the article. However, the invention of *Avery* is a tab that can be used to hold objects when mounting objects such as photographs or signs on walls. (See, patent translation at p. 1, ¶2). There would be no need to align the article using a partially exposed tab, because the alignment of the article with the tab would be irrelevant to the placement of the article on the wall. Additionally, the tab would be completely covered by the object mounted to the wall because it would be unseemly to have the tab show from outside a photograph or sign. Clearly, the tab of *Avery* is designed to be completely concealed. Still further, there would be no motivation to partially cover the adhesive of the tab of *Avery* when applying a photograph because it would reduce the contact surface area of the adhesive with the photograph thereby making the tab less effective to hold the article to the wall.

Because the two-piece release sheet is at best unneeded and at worst unworkable, there is no justification to combine the references.

Secondly, the two references combined by the Office Action, *Avery* and *Kriozere*, do not provide all the required limitations set out in claim 1 and therefore together they fail to adequately support a *prima facie* case of obviousness. For example, claim 1 requires a plurality of rectangular strips, each of the strips having a length substantially greater than its width, the strips being arranged side by side on a transfer sheet. The claim also requires that the release layers be completely bisected along an axis parallel to the length of the strip. *Kriozere* does not show a plurality of rectangular strips. *Avery*, if read carefully, does not disclose a plurality of rectangular strips on a single transfer sheet, either. For example, while Fig. 2 depicts a set of rectangular strips side by side, they are not connected. Fig. 2, at 19 shows that the reinforcing sheet is cut all the way through so that in reality, the plurality of the strips disclosed is not really connected. Moreover, Fig. 2 only illustrates the way in which the laminar object of *Avery* is produced, not the way it is intended to be used. It is manifestly unfair to read *Avery* in view of Applicants' invention to draw a conclusion that Fig. 2 indicates a plurality of side by side strips on the same transfer sheet.

More importantly, claim 1, as amended, requires a continuous and generally planar transfer sheet on which the plurality of strips is adhered. *Avery* does not disclose these limitations because it does not provide for a continuous transfer sheet. As pointed out above with respect to Fig. 2 at 19, the disclosed sheet is cut into segments and therefore not continuous. *Kriozere* cannot provide this element because it does not disclose a transfer sheet at all.

Applicants have further amended claim 1 to include the limitation specifying the adhesive tack strength to require an adhesive of sufficient tack strength to cause a "releasable sticking

sensation”. Support for this amendment can be found at p. 2, lns. 15-17. (Future contact with the item of furniture requires that contact be made by the pet “releasably”.) Neither *Avery* nor *Kriozere* are designed to provide a releasable tackiness for sensation alone and therefore do not disclose or suggest this limitation. For example, *Kriozere* at col. 1, lns. 53-60 makes much of the fact that the strip be closed on itself to create a nonremovable “adhesive-to-adhesive” contact at the open end of the pouch to ensure that no contamination will reach the pouch interior. Clearly, an adhesive-to-adhesive integrity to prevent contamination requires that the adhesive not be easily releasable as required by the claimed invention. This is understandable because the goals of the two inventions are very different. A heavy tack is required to prevent contamination as in *Kriozere* while a light tack is required simply to provide a tacky sensation to small animals as discovered by Applicants.

Similar observations can be made with respect to the *Avery* reference. At p. 1, *Avery* clearly sets out that the pressure sensitive adhesive is used to hold objects such as photographs and signs on a wall for mounting. Such a requirement requires a heavy tack to hold relatively heavy objects on a vertical surface such as a wall. A light tack for one that is “releasable” as required by the claim is not disclosed or suggested by *Avery* because it would not be useful (or preferred) to hang photographs or signs as they would simply fall off the wall.

Finally, Applicants respectfully submit that applying a “presumption” that adhesive tapes are of sufficient tack strength is not sufficient evidence to support a *prima facie* showing of obviousness. The *Avery* reference does not disclose use of an adhesive tape to create a sticking sensation, but rather, an adhesive tape to hold heavy objects on a vertical surface when mounting. (P. 2, ¶2). Similarly, *Kriozere* makes no such disclosure because it discloses a non-removable adhesive-to-adhesive bond. Applicants’ specification is the only document which

discloses and claims an adhesive of sufficient tack strength to create an easily releasable sticking sensation. The law is clear that a *prima facie* case of obvious cannot be established by only using the teachings disclosed in the pending Application. *See, In re Lam*, No. 01-1622, 2002 U.S. App. LEXIS 9704, *12-*13 (Fed. Cir. May 9, 2002) (Board's failure to point to any other reference than the teachings in the specification to show the equivalency of the telescoping and rotational adjustment mechanisms does not create a *prima facie* case of obviousness).

***§103(a) Rejection of Claims over Avery Adhesive
in light of Kriozere as applied to Claim 1 and further in view of Sato***

The Office Action rejects claims 2 and 3 under 35 U.S.C. §103(a) as being unpatentable over *Avery* in view of *Kriozere* and further in view of *Sato* (U.S. Patent No. 4,061,808).

Claims 2 and 3 have been amended to avoid the prior art. Both claims now generally require that the width of the gaps between the strips be a substantial fraction of the width of the strips themselves. Support for this amendment can be found in the specification at p. 5, lns. 15-20 and in Fig. 1 of the drawings. Claim 2 has further been amended to require the limitation that the gaps on the transfer sheet facilitate manual removal of the strips from the transfer sheet. Support for this amendment can be found, for example at p. 5, lns. 15-17 of the specification.

The Office Action makes the observation that a "cut" between the labels of *Sato* is wide enough to distinguish the side of the labels from a bisecting perforation in the release sheet. However, if *Sato* is examined (for instance at Figs. 5 and 6, at 38 and 30, and Fig. 10 at 30) it can be seen that the gaps are extremely small. In fact, *Sato* does not even refer to the gaps as gaps but rather as "cut portions between the labels". *See*, col. 5, lns. 20-25 and lns. 40-43. The purpose of the cut portions is merely to separate neighboring labels on the strip by a cutting operation. *See*, col. 5, lns. 20-24. Further, *Sato* specifically points out at col. 2, lns. 8-11, "the

label strip is separated into a plurality of separate labels by a plurality of transverse cuts at predetermined intervals”.

Because the combination of *Avery*, *Kriozere* and *Sato* does not disclose all the required elements of the invention as claimed in claims 2 and 3, Applicants respectfully assert that the claims are not obvious in view of the prior art and are therefore patentable. Applicants earnestly solicit allowance.

The Office Action also makes the observation that it would have been obvious to one of ordinary skill in the art that spaced individual adhesive tapes could be more easily removed by hand. However, one of ordinary skill in the art would not use the labels of *Sato* in any type of manual operation or to be removed by hand. First, the *Sato* reference clearly shows at Figs. 5, 11 and 12 that the labels of *Sato* are to be used with a machine. Further, the labels of *Sato* are *always* mechanically dispensed. Both the purpose of the invention and the several drawings support this. For example, at col. 1, lns. 7-10, *Sato* points out that his invention relates to a composite label strip “for use with a label applying apparatus. . .” The background section of the reference at col. 1 clearly sets out that the composite strip of *Sato* is to be used with a labeling apparatus. Similarly, in the goals of the invention at col. 1, lns. 65-66 and in the description at col. 5, lns. 55-65, that the strips of *Sato* are designed to be dispensed mechanically through the interaction of perforations in the label and a driving wheel (35) in conjunction with the labels (25 and 28), as shown in Fig. 11 of the reference.

Second, the perforations of *Sato* would prevent the labels from being removed without tearing. At col. 1, ln. 68 through col. 2, ln. 2, it is a clear goal of the invention that the label structure of *Sato* effectively prevents exchange or removal of the labels once they adhere to

commodities. This is because the labels are perforated. When removed by hand, the perforations in the label tear, thus destroying the label. *See*, col. 7, lns. 23-36.

Applicants respectfully submit that the cuts or gaps of *Sato* would not have been obvious to permit easy removal by hand (or manually) because *Sato* clearly teaches a label with perforations that are designed to *prevent* removal by hand. *Sato* further teaches away from application by hand because it sets out that labels are to be used with a machine.

Applicants further submit with respect to claims 2 and 3 that the combination of *Sato* with *Kriozere* and *Avery* is not proper because the combination would result in an unworkable embodiment in any case. First, the gaps and perforations of *Sato* cannot be added to *Kriozere* because there is not a plurality of labels between which the gaps can reside, whatever their dimensions. Moreover, if the adhesive strip of *Kriozere* were perforated, it would not serve its purpose to hermetically seal medical envelopes as required by the disclosure. Second, if the gaps and perforations of *Sato* were applied to *Avery*, an unworkable combination would result. For example, if the release sheet of *Avery* were perforated and separated by gaps as taught by *Sato*, the dispensing mechanism of Fig. 1 would not work. As a continuous layer (12A) was pulled from a dispenser, the perforations would tear, preventing the dispensing of the tape. Further, the gaps in the release sheet and individual tapes would catch on the lower side of the dispensing mechanism (under 11A) again preventing dispensing of the tape. For these reasons, it is respectfully submitted that the combinations submitted by the Office Action would not be obvious to one skilled in the art, but rather is made only with reference to Applicants' invention in hindsight.

§ 103(a) Rejection of Claims over Sekula in view of Geary

The Office Action rejects claims 42-44 under 35 U.S.C. §103(a) as being unpatentable over *Sekula* in view of *Geary* (U.S. Patent No. 2,911,756).

Applicants have amended claim 42 to require that the corrugated substrate is substantially “rigid”. Support for this limitation is found in the Application at page 6, line 9. The new limitation clearly avoids the prior art.

Geary does not disclose or suggest a rigid substrate. Rather, *Geary* discloses that the strips may be in “stacks of short lengths”. These stacks, as shown in Figure 4 of *Geary*, bend easily for deployment and therefore are not rigid. Similarly, *Sekula* discloses only a roll of tape (see, col. 2, ln. 17). The tape of *Sekula* is flexible and not rigid. Since neither reference alone or in combination discloses all the limitations of the claims, it is submitted that claim 42 as amended is patentable.

With respect to claims 43-44, Applicants suggest that these claims are patentable and not obvious under *Sekula* in light of *Geary*. Claims 43 and 44 depend from claim 42; therefore the discussion above with respect to claim 42 also applies to claims 43 and 44. Since the cited references do not establish a *prima facie* case of obviousness of claim 42 and claims 43 and 44 incorporate all the limitations contained in claim 42, claims 43 and 44 are submitted to be patentable. See, *In re Wright* 848 F.2d 1216 (Fed. Cir. 1988).

Further, with respect to claim 44, Applicants have amended the claim to clarify that the color is that of soil. Support for this amendment is found in the specification at p. 6, lns. 9-10. It would not have been obvious to one of ordinary skill in the art to use a *soil* colored substrate even assuming that colored and printed substrates are commonly used for identification and advertising purposes. The purpose of the use of the colored substrate in claim 44 is not for identification or advertising purposes but rather to cause the device to blend into the soil and be

camouflaged. Therefore *Sekula* in view of *Geary* does not disclose, teach or suggest all of the limitations of claim 44. Claim 44 is patentable and not obvious in light of *Sekula* in view of *Geary*.

***§ 103(a) Rejection of Claims over Sekula
in view of Geary and further in view of Anhauser et al.***

The Office Action rejects claim 45 under 35 U.S.C. §103(a) as being unpatentable over *Sekula* in view of *Geary* as applied to claim 42 and further in view of *Anhauser et al.*

Since claim 45 depends from claim 42, the arguments above in reference to claim 42 also apply. Claim 45 should be patentable for these reasons.

Further, Applicants have amended claim 45 to require that the two removable portions abut but do not overlap a central longitudinal axis of the strip. Support for this amendment is found in the specification at p. 6, lns. 16-17 and Fig. 1. Neither *Sekula*, *Geary* nor *Anhauser* disclose, teach or suggest this limitation nor would it have been obvious to one of ordinary skill in the art. A careful reading of *Anhauser* reveals that the two removable portions *must* overlap the longitudinal axis of the strip. For example, Figures 1-5, show that the partial surface areas (first and second release layers) *overlap* the linear axis of the substrate layer (control sheet). (See, Fig. 1 at no. 4.) In fact, *Anhauser* discloses that it is *necessary* for the partial surface areas to overlap so that non-sticky “tabs” can be exposed and grasped when the sheet is bent along the longitudinal axis. (Col. 4, lns. 10-14).

Sekula does not disclose or suggest two side by side removable portions at all. Therefore, this limitation of claim 45 cannot be drawn from this reference. Similarly, *Geary* does not disclose a side by side release layer which runs the longitudinal length of the strip, nor does it show an abutment of the release layers, so the limitations of claim 45 cannot be drawn from this

reference. Therefore, amended claim 45 is patentable and not obvious in view of the cited references.

***§103 (a) Rejection of Claims over Sekula in view of Geary
and Anhauser et al. and further in view of Sato***

The Office Action rejects claim 47 under 35 U.S.C. §103(a) as being unpatentable over *Sekula* in view of *Geary* and *Anhauser et al.* and further in view of *Sato*.

Initially, since claim 42 is patentable over the art of record and claim 47 depends from claim 42, claim 47 should be patentable because it includes all of the limitations of allowable claim 42.

Applicants have amended claim 47 to require the limitation of a gap having a width which is a substantial fraction of the width of any one of the plurality of strips. Support for the amendment can be found in Fig. 1 and in the specification, p. 1, lns. 3-4. This limitation avoids the prior art because neither *Sekula*, *Anhauser* nor *Sato* discloses a gap which is a significant fraction of the strip.

As an initial matter, neither *Sekula* nor *Anhauser* show a plurality of strips on a substrate, nor do they show or suggest that the substrate can overlap a strip by any gap at all. Therefore, it is respectfully submitted that there would be no way to apply the “cut” of *Sato* to either of the inventions disclosed in *Anhauser* or *Sekula*. Since there is no way to apply the disclosure of the *Sato* reference to either of these disclosures, it is submitted that it would not be obvious to one of reasonable skill in the art to do so.

Focusing now on *Sato*, the Office Action makes the observation that it would be obvious to one skilled in the art that the spaced individual adhesive tapes could be easily removed by hand. *Sato* discloses exclusively a *mechanized* method of distributing the tape. For example, both the prior art at Fig. 5, and the disclosed invention of Figs. 11 and 12 both show distribution

of the tape through a machine. The specification of *Sato* also clearly points out that the invention is targeted at and useful only with a “label applying apparatus”. For example, in the background at col. 1, lns. 5-11 and in the description of the preferred embodiment at col. 5, lns. 55-64.

It is further respectfully submitted that *Sato* does not disclose a gap having a width which is a substantial fraction of the strip. Referring to the drawings of *Sato*, Fig. 6 and Fig. 8 do not disclose a gap (30) which is a significant fraction of the width of the strip. The “gap” of *Sato* is actually referred to in the reference as a “cut”. One skilled in the art would understand a “cut” to be a partition and not particularly a gap just by the common engineering definition of the word. It is submitted that the drawings of *Sato* overemphasize the cut to make a point, but do not disclose a significant gap between the strips. More certainly, the cut disclosed by *Sato* is not a *significant portion of the width of the strip*, even assuming that the drawings are not exaggerated. For these reasons, it is respectfully submitted that neither *Sato*, *Anhauser* nor *Sekula* show all the limitations of claim 47. Therefore, claim 47 is patentable.

***Applicants Have Submitted Evidence of
Secondary Considerations of Non-Obviousness***

The presentation of evidence of secondary considerations is often the key to overcoming an obviousness rejection. For example, the Federal Circuit has held that

Evidence of secondary considerations may often be the most probative and cogent evidence in the record. It may often establish that an invention appearing to have been obvious in light of the prior art was not. It is to be considered as part of all the evidence, not just when the decision maker remains in doubt after reviewing all the art. *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 1538-40, 218 U.S.P.Q. 871, 879 (Fed. Cir. 1983).

In a crowded field, such as that presented by the prior art in this case, small differences may make all the difference as to non-obviousness. For example, the Federal Circuit recognized this principle as follows:

Thus when differences that may appear technologically minor nonetheless have a practical impact, particularly in a crowded field, the decision-maker must consider the obviousness of the new structure in this light. Such objective indicia as commercial success, or filling an existing need, illuminate the technological and commercial environment of the inventor, and aid in understanding the state of the art at the time the invention was made. *Continental Can Co. USA v. Monsanto Co.*, 948 F.2d 1264, 20 U.S.P.Q. 2d 1746, 1752 (Fed. Cir. 1991).

When evidence of secondary consideration exists, it is always to be considered, not merely when the Examiner remains in doubt after reviewing all the prior art. *Cable Elec. Prods., Inc. v. Genmark, Inc.*, 770 F.2d 1015, 226 U.S.P.Q. 887 (Fed. Cir. 1985).

An Applicant need not show that all possible embodiments within the claims are successfully commercialized in order to rely on the success of the marketplace of the embodiment that was commercialized. *Applied Materials, Inc. v. Advance Semiconducting Materials Amc.*, 98 F.3d 1563, 40 U.S.P.Q. 2d 1481, 1486 (Fed. Cir. 1996), *cert denied*, 117 S.Ct. 1822 (1997).

The Board has recognized that if the commercial success is due to the merits of the claimed invention, the evidence of nonobviousness is to be accorded substantial weight. *Ex parte Remark*, 15 U.S.P.Q.2d 1498 (B.P.A.I. 1990).

The Federal Circuit has held that a *prima facie* case of nexus is made out when the patentee shows that there is commercial success, and the product or method that is commercially successful is the invention disclosed and claimed in the patent. *Demaco Corp. v. F. von Langsdorf Licensing Ltd.*, 851 F.2d 1387, 7 U.S.P.Q. 2d 1222, 1226 (Fed. Cir. 1988). A patentee is not required to prove as part of its *prima facie* case that the commercial success of the patented invention is not due to factors other than the patented invention. It is sufficient to show that the commercial success was of the patented invention itself. A requirement for proof of the negative

of all imaginable contributing factors would be unfairly burdensome, and contrary to the ordinary rules of evidence. *Id.* at 1226-27.

A patent owner's lack of previous experience in a relevant market combined with high sales volume of the product provides an inference of a nexus between a commercial success and the patented invention and are probative evidence of nonobviousness. *Pro-Mold & Toll Co. v. Great Lake Plastics, Inc.*, 75 F.3d 1568, 37 U.S.P.Q. 2d 1626 (Fed. Cir. 1996). The Federal Circuit pointed out specifically in this case that the lack of market power in a field suggests that the novel features of the patented invention led to the commercial success.

Industry recognition is also probative in nonobviousness when related to the claimed invention. *In re Metz*, 173 F.3d 433 (Fed. Cir. 1998) (unpublished).

A combination of commercial success and copying by an infringer provides strong evidence of secondary consideration supporting a decision of nonobviousness. *Heidleberg Harris, Inc. v. Mitsubishi Heavy Industries, Ltd.*, Civ. App. No. 99-1100, 2000 U.S. App. LEXIS 23757, *30 (Fed. Cir. Sept. 18, 2000) (unpublished). If the evidence of copying includes reports indicating that the infringer followed the patentee's design and advertisement, these form an extremely persuasive indication of nonobviousness. *Id.* at *29-*30.

In this case, Applicants provide the Declaration of Ms. Bonnie Pemberton, the inventor, and the Declaration of Mr. Chris Ruben, a sales executive familiar with the products incorporating the invention as evidence of several secondary considerations that indicate that the invention is not obvious. *See*, Exhibits 1, 2.

Ms. Pemberton testifies that from humble beginnings, the product incorporating the claimed invention rose from 0% market share to controlling almost 80% of the market share available. *See*, Declaration of Bonnie Pemberton at ¶8. The Declaration of Mr. Chris Ruben at

¶4 concurs. Ms. Pemberton further testifies that the details of market share, including the approximately size of the market and her percentage of sales. *See*, Declaration of Bonnie Pemberton at ¶¶7-8. She also testifies that her product incorporating the claimed invention was a replacement of the prior art which was greeted well by customers who voiced to her the advantages of the claimed features, including but not limited to, the features of the multiple layers, the bisected release layer and that the strength of the adhesive is sufficient to cause an unpleasant sticking sensation to pets. *See*, Declaration of Bonnie Pemberton at ¶¶ 9-11. Additionally, customers have also voiced their opinions on the advantages of the corrugated embodiment; specifically, the corrugated substrate that contains an adhesive on one side and a strip that is releasable adhered to the adhesive. *See*, Declaration of Bonnie Pemberton at ¶11. The evidence shows that the claimed features responsible for the sales increase as opposed to other potential avenues such as advertising. Specifically, Ms. Pemberton testifies that the company doesn't spend a significant percentage of its budget on advertising and that the success of the product was because of the features. *See*, Declaration of Bonnie Pemberton at ¶14. Perhaps most telling, Applicants have sold over 1,500,000 packages of its product incorporating the invention since it was introduced in the market. *See*, Declaration of Bonnie Pemberton at ¶6.

Ms. Pemberton goes on to testify that she and her company were relatively inexperienced in the market before the success of the product and that the success of the product again was due to its features, and not her experience. *See*, Declaration of Bonnie Pemberton at ¶12.

The invention has been recognized in the industry with various awards. For example, in 1997 and 2003 the product incorporating the claimed invention won the "Editors Choice" award from Cat Fancy Magazine. Another example is the award for "Excellence" in 1999 from CATsumer Report. Still another example is the receipt of a formal "endorsement" from

CATNIP! Newsletter in 1999. A further example is the “Seal of Approval” from the ASPCA in 2000. *See*, Declaration of Bonnie Pemberton at ¶13, Exhibits H, I and J.

The products incorporating the invention have been recommended in award-winning books, including:

- **Complete Kitten Care**, by **Amy D. Shojai**, a nationally known authority on pet care and behavior, a spokesperson for Purina®, and an award-winning author of more than a dozen nonfiction pet books.
- **Kittens for Dummies**, by **Dusty Rainbolt**, a nationally known authority on cat care and behavior, and an award-winning author and a regular contributor to the Whole Cat Journal and City + Country Pets.
- **The Cat Fanciers’ Association Complete Cat Book**, by **Mordecai Siegel**, a nationally known, highly-regarded and widely published authority on pet care.
- **Think Like A Cat**, by **Pam Johnson-Bennett**, a Certified Animal Behavior Consultant and clinical member of the International Association of Animal Behavior Consultants. She is the author of a number of award-winning and critically acclaimed books and one of the country’s most well-known and popular experts on cat behavior. *See*, Declaration of Bonnie Pemberton at ¶22.

Mr. Ruben testifies also that the claimed features of the invention have been mentioned to him favorably by customers large and small. Specifically, Mr. Ruben sets out that the features claimed in independent claims 1 and 42 among others are responsible for the success of the product. *See*, Declaration of Chris Ruben at ¶¶6-9.

The evidence also shows the nonobviousness of the invention by virtue of the close copying of the invention by at least two competitors. The first competitor is a larger, more well-established company than Applicants’ company. *See*, Declaration of Bonnie Pemberton at ¶18, Exhibit D. Mr. Ruben also testifies that the product of the inventor incorporating the elements of the invention and at least one competitor’s product move in the same channels of trade and are purchased by the same customers. *See*, Declaration of Chris Ruben at ¶5. For example, with respect to the first competitor, Applicants respectfully direct the attention of the Examiner to the

virtual duplication of the product. The first competitor has copied the size and dimensions including the bisected release layer in its product. Moreover, in order to closely associate the competitive product with the product of Applicants' which incorporates the claimed invention, the first competitor has virtually copied the label and the instruction sheet, presumably in order to lead customers to believe that a competitive product incorporates the features of the claimed invention. *See*, Declaration of Bonnie Pemberton at ¶19, Exhibits A, D. The Examiner will also note that the competitive product does incorporate the claimed features of at least claim 1 including multiple layers and the bisected release layer. The instructions of the competitor specifically point out the structure and function of the features of the claimed invention. The first competitor has also used a nontoxic adhesive similar to that claimed by the invention. *See*, Declaration of Bonnie Pemberton at ¶¶18-19, Exhibit C, E, K.

As another example, the second competitor has also copied Applicants' product incorporating the claimed invention. *See*, Declaration of Bonnie Pemberton at ¶¶20-21, Exhibits F, G.

The second competitor not only copies the bisected release layer but the structure of the claimed invention. Moreover, the second competitor adopts similar product packaging and instructions to those of the inventor to leverage the apparent similarity to the claimed invention. *See*, Declaration of Bonnie Pemberton at ¶¶20-21, Exhibits F, G.

In summary, Applicants respectfully submit that the evidence of the secondary considerations provided is sufficient to overcome doubt as to the nonobviousness of the claimed invention.

Request For Information

On November 15, 2004, Applicants filed a Petition to Make Special as a result of an infringing device that was actually on the market and a method that was in use. The Office Action requests additional information regarding this device and method that is referred to in the Petition to Make Special.

The device referred to in Applicants' Petition to Make Special is sold under the name PAWS AWAY. A copy of the product is shown at Exhibit D to Ms. Bonnie Pemberton's Declaration. A copy of the packaging and instructions sold with the PAWS AWAY product are shown in Exhibit E to Ms. Bonnie Pemberton's Declaration. A copy of a photograph of a display of the PAWS AWAY product is attached as Exhibit L to Ms. Bonnie Pemberton's Declaration. The PAWS AWAY product is believed to be manufactured by Cosmic Pet Products, Inc.

The exact date that the PAWS AWAY product went into public use is not known to Applicants. *See*, Declaration of Bonnie Pemberton at ¶18. However, Applicants were not aware of the PAWS AWAY product until after Applicants' devices as shown in Exhibits A and B were invented. *See*, Declaration of Bonnie Pemberton at ¶18. A review of the instructions for Applicants' device and the PAWS AWAY product further corroborates the conclusion that the PAWS AWAY product was in public use after Applicants' claimed device because the PAWS AWAY instructions are almost identical copies of Applicants' instructions. *See*, Declaration of Bonnie Pemberton ¶19, Exhibits C & E.

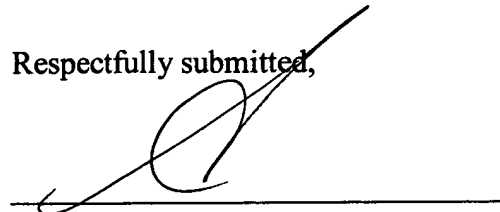
CONCLUSION

In view of the above, it is submitted that Claims 1-3 and 42-45 and 47 are in condition for allowance.

Applicants respectfully request reconsideration of the Application and earnestly solicit allowance. Should it facilitate allowance of the Application, the Examiner is invited to telephone the undersigned attorney.

Dated: September 6, 2006

Respectfully submitted,

A handwritten signature in black ink, appearing to read "George R. Schultz", is written over a horizontal line.

George R. Schultz
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